



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/875,053	06/07/2001	Kimberly Patrick Farrow	7099-1461	6053

826 7590 12/27/2004

ALSTON & BIRD LLP
BANK OF AMERICA PLAZA
101 SOUTH TRYON STREET, SUITE 4000
CHARLOTTE, NC 28280-4000

EXAMINER

ROSEN, NICHOLAS D

ART UNIT	PAPER NUMBER
----------	--------------

3625

DATE MAILED: 12/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/875,053

Applicant(s)

FARROW ET AL.

Examiner

Nicholas D. Rosen

Art Unit

3625



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 13 and 14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claims 1-12 have been examined.

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 6, 2004, has been entered.

Claim Objections

Claim 2 is objected to because of the following informalities: In the third line of claim 2, "the client device" should be "the client device," since claim 1 provides antecedent basis for only one. Appropriate correction is required.

Claim 4 is objected to because of the following informalities: Claim 4 recites executable code as method steps: "the executable code comprises: detecting conditions . . . and generating updates." To be consistent, the executable code should, for example, be described as comprising "code which detects conditions . . . and code which generates the updates." Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

Art Unit: 3625

art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-6 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The new element of claim 1, "receiving an indication to purchase the offering of the seller directly *via the associate's web site* based on input from the client device," appears to differ from what is set forth in the written specification (paragraph 41) and the drawings (Figure 7), where the seller receives indication to purchase the offering of the seller directly based on input from the client device, with no teaching that the indication is received via the associate's web site.

Claims 7-10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The new element of claim 7, "receiving an indication to purchase the offering of the seller directly *via the associate's web site* based on input from the client device," appears to differ from what is set forth in the written specification (paragraph 41) and the drawings (Figure 7), where the seller receives indication to purchase the offering of the seller directly based on input from the

client device, with no teaching that the indication is received via the associate's web site.

Claim 11 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The new element, "receiving an indication to purchase the offering of the seller directly *via the associate's web site* based on input from the client device," appears to differ from what is set forth in the written specification (paragraph 41) and the drawings (Figure 7), where the seller receives indication to purchase the offering of the seller directly based on input from the client device, with no teaching that the indication is received via the associate's web site.

Claim 12 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The new element, "receiving an indication to purchase the offering of the seller directly *via the associate's web site* based on input from the client device," appears to differ from what is set forth in the written specification (paragraph 41) and the drawings (Figure 7), where the seller receives indication to purchase the offering of the seller directly based on input from the client device, with no teaching that the indication is received via the associate's web site.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-6

Claims 1, 2, 5, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker ("Beyond the Banner Ad") in view of official notice. As per claim 1, Walker discloses, in a network comprised of a client device and at least two server devices, a method for providing real-time price information, the method comprising: receiving at a first server device from the client device, a request for content, wherein the content is contained in an associate's web site that includes an offering made by a seller, wherein the first server maintains the associate's web site, and wherein an associate is an entity other than the seller (last seventeen lines, from "Internet advertisers are experimenting

with new ad formats”). Walker is not explicit about the servers, but official notice is taken that it is well known for web sites to be hosted on servers, and accessed from client devices such as home computers, making a first server to host one of the “thousands of Web sites,” and a client device to enable a potential customer to view the content of the Web site, obvious to one of ordinary skill in the art of electronic commerce at the time of applicant’s invention, for the obvious advantage of enabling the particulars disclosed by Walker to function. Likewise, it is held to have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant’s invention for one of “thousands of Web sites” to provide the requested content, since a web site which did not provide requested content would soon lack visitors, and be a poor place for a banner ad.

As above, Walker discloses “real-time ad updating,” so that, “A travel ad, for instance, can automatically update the number of available seats and pricing inside a banner ad running on thousand of Web sites.” This is “substantially continuously providing the client device updates to variable data of the offering is subject to update by a second server;” as with the first server, the existence of the second server is held to be obvious based on the disclosed functionality of the banner ad. Walker further discloses receiving an indication to purchase the offering of the seller directly via the associate’s web site based on input from the client device (as above, especially the sentence beginning “The box below the Get-a-Fare vacations banner ad”).

As per claim 2, Walker does not expressly disclose determining by at least one of the client device and the first server whether the content refers to variable data that is

subject to modification by the second server, but it is held that the interaction between the first and second server if the content is updated, as disclosed by Walker, would obviously involve the first server (and the client, if the client device displays, e.g., changing numbers) in determining whether the content includes or refers to variable data, e.g., a banner ad containing changing numbers.

As per claim 5, Walker discloses providing, by the second server, an interface with a purchasing service (last seventeen lines, from "Internet advertisers are experimenting with new ad formats," especially "The box below the Get-a-Fare vacations banner ad").

As per claim 6, Walker does not expressly disclose narrowcasting at least a portion of the variable data; and providing variable data that has been narrowcasted, but, in addition to disclosing variable data, as set forth above, Walker discloses narrowcasting (see section beginning from, "The truth is, targeting"). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to narrowcast at least a portion of the variable data; and provide variable data that had been narrowcasted, for the obvious advantage, implied by Walker, of providing pitches for products that people are likely to buy.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker and official notice as applied to claim 1 above, and further in view of Clenaghan et al. (U.S. Patent Application Publication 2002/0052816). Walker does not disclose transmitting executable code from the first server to the client device, wherein the executable code executing on the client device periodically establishes a

communication link with the second server to receive any updates to variable data referenced in the content, but Clenaghan teaches a Java applet periodically querying a server for updated information (paragraph 0008), and official notice is taken that it is well known for Java applets to comprise executable code transmitted from servers to client devices. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to transmit executable code from the first server to the client device, wherein the executable code executing on the client device periodically established a communication link with the second server to receive any updates to variable data referenced in the content, for the obvious advantage of arranging for updated information to be available to the user.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker and official notice as applied to claim 1 above, and further in view of Cole et al. (U.S. Patent 6,074,434). Walker does not disclose transmitting executable code from the first server to the client device, wherein the executable code executing on the client device comprises: code detecting conditions associated with the client device that indicate a need for updates to the variable data; and code generating the updates to the variable data based on the detected conditions associated with the client device. However, Cole teaches transmitting executable code from a server to a client device, wherein the executable code executing on the client device comprises: code detecting conditions associated with the client device that indicate a need for updates to the variable data; and code generating the updates to the variable data based on the detected conditions associated with the client device (Abstract; column 6, lines 5-41; column 7, lines 8-19).

Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to transmit executable code from the first server to the client device, wherein the executable code executing on the client device comprises: code detecting conditions associated with the client device that indicate a need for updates to the variable data; and code generating the updates to the variable data based on the detected conditions associated with the client device, for the obvious advantage of making the information on which the user of a client may rely current and valid.

Claims 7-10

Claims 7, 9, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker ("Beyond the Banner Ad") in view of official notice. As per claim 7, Walker discloses, in a network comprised of a client device and at least two server devices, a method for providing real-time price information, the method comprising: receiving at a first server device from the client device, a request for content, wherein the content is contained in an associate's web site that includes an offering made by a seller, wherein the first server maintains the associate's web site, and wherein an associate is an entity other than the seller (last seventeen lines, from "Internet advertisers are experimenting with new ad formats"). Walker is not explicit about the servers, but official notice is taken that it is well known for web sites to be hosted on servers, and accessed from client devices such as home computers, making a first server to host one of the "thousands of Web sites," and a client device to enable a potential customer to view the content of the Web site, obvious to one of ordinary skill in the art of electronic

commerce at the time of applicant's invention, for the obvious advantage of enabling the particulars disclosed by Walker to function. Likewise, it is held to have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for one of "thousands of Web sites" to provide the requested content, since a web site which did not provide requested content would soon lack visitors, and be a poor place for a banner ad. A second server, in turn, is obvious as a means to provide the disclosed banner ad, including the variable data of the offering, which Walker expressly discloses.

As above, Walker discloses "real-time ad updating," so that, "A travel ad, for instance, can automatically update the number of available seats and pricing inside a banner ad running on thousand of Web sites." This is "substantially continuously providing the client device updates to variable data of the offering referenced in the associate's web site, wherein the variable data of the offering is subject to update by a second server;" as with the first server, the existence of the second server is held to be obvious based on the disclosed functionality of the banner ad. Walker further discloses receiving an indication to purchase the offering of the seller directly via the associate's web site based on input from the client device (as above, especially the sentence beginning "The box below the Get-a-Fare vacations banner ad").

As per claim 9, Walker discloses providing, by the second server, an interface with a purchasing service (last seventeen lines, from "Internet advertisers are experimenting with new ad formats," especially "The box below the Get-a-Fare vacations banner ad").

As per claim 10, Walker does not expressly disclose narrowcasting at least a portion of the variable data; and providing variable data that has been narrowcasted, but, in addition to disclosing variable data, as set forth above, Walker discloses narrowcasting (see section beginning from, “The truth is, targeting”). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant’s invention to narrowcast at least a portion of the variable data; and provide variable data that had been narrowcasted, for the obvious advantage, implied by Walker, of providing pitches for products that people are likely to buy.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker and official notice as applied to claim 7 above, and further in view of Clenaghan et al. (U.S. Patent Application Publication 2002/0052816). Walker does not disclose transmitting executable code from the second server to the client device, wherein the executable code executing on the client device periodically establishes a communication link with the second server to receive any updates to variable data referenced in the content, but Clenaghan teaches a Java applet periodically querying a server for updated information (paragraph 0008), and official notice is taken that it is well known for Java applets to comprise executable code transmitted from servers to client devices. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant’s invention to transmit executable code from the second server to the client device, wherein the executable code executing on the client device periodically established a communication link with the second server to

receive any updates to variable data referenced in the content, for the obvious advantage of arranging for updated information to be available to the user.

Claim 11

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker ("Beyond the Banner Ad") in view of official notice. Claim 11 is essentially parallel to claim 1, and rejected on much the same grounds. Walker does not expressly disclose a computer-readable medium containing instructions for causing a data processing system to perform the method of claim 1, but does disclose a method involving web sites, which inherently involve computers, and discloses, for example, that a travel ad can automatically update the number of available seats and pricing, implying operation of a computer program. Official notice is taken that computer-readable media containing instructions for controlling data processing systems are well known; hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to use such a medium, for the obvious advantage of instructing a data processing method to perform the indicated steps.

Claim 12

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker ("Beyond the Banner Ad") in view of official notice. Claim 12 is essentially parallel to claim 7, and rejected on much the same grounds. Walker does not expressly disclose a computer-readable medium containing instructions for causing a data processing system to perform the method of claim 7, but does disclose a method involving web

sites, which inherently involve computers, and discloses, for example, that a travel ad can automatically update the number of available seats and pricing, implying operation of a computer program. Official notice is taken that computer-readable media containing instructions for controlling data processing systems are well known; hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to use such a medium, for the obvious advantage of instructing a data processing method to perform the indicated steps.

Response to Arguments

Applicant's arguments with respect to claims 1-12 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Messer (U.S. Patent 5,99,1,740) discloses a data processing system for integrated tracking and management of commerce related activities on a public access network.

Miyashita (U.S. Patent Application Publication 2001/0014876) discloses a network system, auction server, digital content distributing system, and digital content distributing method (note paragraph 13). Davis et al. (U.S. Patent Application Publication 2002/0040395) disclose a method of monitoring client interaction with a file downloaded from a server. Park et al. (U.S. Patent Application Publication

2002/0072981) disclose a search engine adapted to permit real time querying of a set of Internet sites. Davis et al. (U.S. Patent Application Publication 2002/0099812) disclose a method and apparatus for tracking client interaction with a network resource and creating client profiles and resource database. Helot et al. (U.S. Patent Application Publication 2002/0169675) disclose a system and method for ordering consumer items in electronic commerce. Nowers et al. (U.S. Patent Application Publication 2003/0033205) disclose a method and system for facilitating fulfillment of electronic commercial transactions.

Bierne ("Payless Sets Targeted 'Net Biz,") discloses banner ads on web sites, supported by a backroom technology that enables rate changes to be posted in real time.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas D. Rosen whose telephone number is 703-305-0753. The examiner can normally be reached on 8:30 AM - 5:00 PM, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703-308-1344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Non-official/draft communications can be faxed to the examiner at 703-746-5574.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

Art Unit: 3625

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nicholas D. Rosen

NICHOLAS D. ROSEN
PRIMARY EXAMINER

December 21, 2004